

PATENT**REMARKS**

Reconsideration of the rejections set forth in the Office action dated 4/20/2004 is respectfully requested under the provisions of 37 CFR §1.116.

No amendments were made to the claims.

Applicant thanks the Examiner for entering the drawing amendments of 1/21/04 and for noticing that the captions for 170, 174, and 176 were omitted on the supplied sheet 3/17. The attached replacement for sheet 3/17 includes the previously omitted captions.

The 2-month period from the mailing date of the Office action dated 4/20/2004 is 6/20/2004 which falls on a Sunday. Pursuant to 37 CFR 1.7 this reply was faxed to the PTO on 6/21/2004 and thus falls within the 2-month period to claim the benefit of expiration of the shortened statutory period for reply to be that when the advisory action is mailed.

Applicant thanks the Examiner for the interview of 5/7/04. We discussed aspects of the invention and claim 1. The applicant and the Examiner did not reach agreement. The Examiner asserted that the information received by the cryptographic service provider in limitation (d) is an acknowledgement of the contract. Applicant asserted that the information received by the cryptographic service provider in limitation (d) is the information upon which the cryptographic service is to be applied to. The applicant strongly believes the claim to not be anticipated by Yamamoto and clarifies the reasons herein.

I. Rejections under 35 USC §102(e)

Claims 1-5, 9, 11-13, 15-19 and 23 stand rejected as being anticipated by Yamamoto (6,078,663).

PATENT

Applicant respectfully traverses this rejection because the Examiner has not established a prima facie case of anticipation.

The Examiner's position is that the information sent by the user to the cryptographic service provider is an acceptance of the contract. Applicant maintains that the information sent from the user is the information upon which the cryptographic service provider applies the contracted-for cryptographic service. Applicant respectfully, but strongly, believes that the Examiner's position is inconsistent with the plain text of the claim and that the anticipation rejection of these claims should be withdrawn.

In addition, applicant respectfully traverses the assertion made in the response to arguments section 10 in the final office action dated 4/20/2004 that the cryptographic service provider can be interpreted as the information providing center. The application throughout uses the term cryptographic service provider as a provider of cryptographic services to a user --- that is, of taking information provided by the user and applying the contracted-for cryptographic operation on that information. An information providing center that encrypts its information that is sent to a user in no way provides the same services to the user as does the cryptographic service.

A prima facie case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art.

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990) (A[T]he [prior art] reference must describe the applicant=s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.@ (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997)

Previously presented claim 1 is directed to a method for pricing a cryptographic service (for example, but without limitation, a service for encrypting data). A user who desires to off-load a cryptographic operation from the user's computer can select a

PATENT

cryptographic service provider to perform the cryptographic operation for the user (by selecting the appropriate cryptographic service). The cryptographic service provider receives a request for the desired service and generates a contract based on a variable pricing scheme and sends the contract to the user. On acceptance of the contract, the user sends information to the cryptographic service provider. The cryptographic service provider then causes the contracted-for cryptographic service to be applied to the user-supplied information and thus satisfy the contract. Thus, the user can off-load the burden of performing the cryptographic service on the information from the user's computer to the cryptographic service.

To summarize, the user contracts with a cryptographic service provider for a cryptographic service to be supplied by the cryptographic service provider, provides information to cryptographic service provider to which the cryptographic service is to be applied, and the cryptographic service provider then applies the contracted-for cryptographic service to the information that was provided by the user.

This aspect of the invention is captured in previously presented **Claim 1**:

A method for pricing a cryptographic service on a network utilizing one or more cryptoservers, comprising:

- (a) receiving a request for the cryptographic service from a user utilizing the network, wherein the request is received by a cryptographic service provider;
- (b) generating a contract based on a variable pricing scheme in response to the request; and
- (c) sending the contract from the cryptographic service provider to the user utilizing the network;
- (d) receiving, by the cryptographic service provider, information from the user; and
- (e) applying the cryptographic service to the information using the one or more cryptoservers to satisfy the contract.

PATENT

The Examiner has cited Yamamoto Column 16, lines 20-41 and figures 4 and 11 as teaching steps (d) and (e).

Yamamoto teaches techniques for distributing encrypted information from an information providing center to a user who has agreed to a fee for the providing of the information as well as the strength of the encryption used to protect the provided information. The information is stored at the information providing center.

Yamamoto teaches: 1) a database at the information providing center; 2) contracting for information from the database at a specified encryption strength, and 3) providing the data so encrypted.

The invention of claim 1 includes the limitations of elements (d) and (e). That is, that the cryptographic service provider receives information *from the user* and that the contracted-for cryptographic service be applied to *this information* to satisfy the contract.

While the claims must be given their broadest *reasonable* interpretation by the Examiner, the Examiner must apply the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. (MPEP 2111).

The Examiner's position that limitations (d) and (e) somehow apply to the *contract* sent by the cryptographic service to the user is not supported by the plain meaning of the words in the claim. In particular, limitations (d and e) "receiving, by the cryptographic service provider, information from the user and applying the cryptographic service to the information using the one or more cryptoservers to satisfy the contract" clearly require that the user send information to the cryptographic service provider and that the contracted-for cryptographic service is applied to the information to satisfy the contract. At no point in the claims or in the specification is there a suggestion that the contract is the information that is being operated on by the cryptographic service. In addition, applicant respectfully asserts that one skilled in the art would not find the Examiner's interpretation to be reasonable.

PATENT

Nothing in Yamamoto teaches or enables applying a cryptographic service on information provided by the user. Thus, Yamamoto does not anticipate the invention of Claim 1. Claims 11 and 15 are not anticipated for substantially the same reasons.

Claims 2-5 and 9 (directly or indirectly) depend on and further limit claim 1 and are thus also not anticipated.

Claims 12-13 (directly or indirectly) depend on and further limit claim 11 and are thus also not anticipated.

Claims 16-19 and 23 (directly or indirectly) depend on and further limit claim 15 and are thus also not anticipated.

For these reasons, applicant respectfully traverses the 102(e) rejection of claims 1-5, 9, 11-13, 15-19 and 23.

II. Rejections under 35 USC §103(a)

Claims 6-8, 14, 20-22, and 24 stand rejected as being unpatentable over Yamamoto in view of Coyle (6,269,157).

Claim 10 stands rejected as being unpatentable over Yamamoto in view of Schneier et al (5,956,404).

Applicant respectfully traverses these rejections as a prima facie case of obviousness has not been established for either rejection.

A prima facie of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The arguments from the office action reply sent 1/21/04 are again asserted.

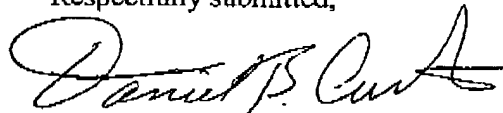
No additional fee is believed to be required for this amendment. However, the undersigned Xerox authorized attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This

PATENT

also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,



Daniel B. Curtis
Attorney for Applicants
Reg. No. 39,159
(650) 812-4259
dbcurtis@parc.com